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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/558,845	08/21/2006	Patrick Ferguson	N22PI248US	7085
3017 7590 04/13/2010 BARLOW, JOSEPHS & HOLMES, LTD. 101 DYER STREET 5TH FLOOR PROVIDENCE, RI 02903			EXAMINER FRANGE, SHARON M	
			ART UNIT 3728	PAPER NUMBER
			MAIL DATE 04/13/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/558,845

Applicant(s)

FERGUSON, PATRICK

Examiner

SHARON M. PRANGE

Art Unit

3728

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-15 and 17-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13-15,17-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This is in response to Applicant's amendment in which claims 1, 3, 7-11, 13, 15, and 17-19 have been amended, claims 2, 12, and 16 have been canceled, and claims 24-26 have been added.

Terminal Disclaimer

1. The terminal disclaimer filed on 12/14/09 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 7,569,795 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1, 3-6, 8-11, 13-15, 17, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber et al. (US 5,829,171), herein Weber, in view of Morris et al. (US 5,923,496), herein Morris.

Weber discloses a heater element (heating element 60) for use in an insole which is formed by etching. The pattern of the heating element is selected so that a first part provides a different heat output than a second part (Fig. 8). A thermal protection device (thermocouple 65) provides temperature control of the heater element. The heater element has termination pads (plug tab 64) for connection to a control system

(plug 68). The heater element is laminated with a layer of insole face fabric (top cover layer 42) and a backing layer (layer 26). The face fabric is attached to the heater element by a thermoplastic web (thermoplastic material layer 24). (column 2, lines 62-65; column 5, lines 1-7, 43-46; column 6, lines 21-34; Fig. 3, 8)

Weber does not disclose that the heater element is formed of a metallised fabric.

Morris teaches an electrical circuit which is formed of a porous flexible metallised fabric which is photochemically etched to create the circuit pattern. The fabric is made up of individual components/yarns/fibers (individual cloth fibers) which are each encapsulated with metal (column 1, lines 55-62). The fabric may be polyester which is coated with nickel (column 5, lines 45-52). The fabric is photochemically etched to provide the desired circuit pattern (column 5, lines 53-66). The individual fibers are encapsulated in metal after the manufacture of the porous fabric (column 2, lines 29-32). It would have been obvious to one of ordinary skill in the art at the time of the invention to have used a metallised fabric, as taught by Morris, as the heater element of the insole of Weber, as this would be a simple substitution of one type etched circuit for another, with the predictable result of providing an element which is sufficiently flexible and porous to be placed in an insole.

Regarding claim 5, Weber does not disclose that the thermal protection device is a thermistor. Official Notice is taken that it is old and conventional to use a thermistor to monitor and control temperature in an electrical circuit. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention in view of the Official Notice to have used a thermistor as the thermal protection device.

4. Claims 7 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber and Morris, as applied to claims 1, 3-6, 8-11, 13-15, 17, 25, and 26, further in view of Enticknap (GB 2092868).

The combination of Weber and Morris does not disclose that the individual components/fibers are encapsulated in metal prior to the manufacture of the porous fabric.

Enticknap teaches that a metallised fabric may be metallised before or after spinning, weaving, or felting (page 1, lines 35-43). It would have been obvious to one of ordinary skill in the art at the time of the invention to have metallised the fabric of the combination of Weber and Morris prior to weaving, as this would be a simple substitution of one well known method of metalizing fabric for another.

5. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weber and Morris, as applied to claims 1, 3-6, 8-11, 13-15, 17, 25, and 26, further in view of Bondy (US Patent No. 4,665,301).

Weber and Morris do not disclose that the insole may be trimmed to several possible shapes or sizes.

Bondy teaches that a heated insole may be trimmed to fit the footwear in which it is to be used (column 2, lines 41-45; Fig. 1). It would have been obvious to one of ordinary skill in the art at the time of the invention to have made the insole so that it

could be trimmed, as taught by Bondy, in order to allow one size insole to be custom fitted to the footwear in which it will be used.

6. Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber and Morris, as applied to claims 1, 3-6, 8-11, 13-15, 17, 25, and 26, further in view of Oakley (US Patent No. 4,864,740) and Mathiowitz et al. (US Patent No. 6,143,211), herein Mathiowitz.

Weber and Morris do not disclose heat-activatable agents in the insole.

Oakley teaches providing antimicrobial agents or fragrances in a shoe insole in order to enhance the cleanliness and freshness of the shoe (column 2, lines 61-68; column 2, lines 1-8). It would have been obvious to one of ordinary skill in art at the time of the invention to have included an antimicrobial agent or fragrance to the insole, as taught by Oakley, in order to enhance the cleanliness and freshness of the shoe.

Oakley does not teach that the antimicrobial agent or fragrance is in the form of microcapsules.

Mathiowitz teaches that agents such as fragrance can be stored and delivered in microcapsules which release the agent in response to heat. The release rate may be controlled by the size of the capsule (column 1, lines 12-23). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the antimicrobial agent or fragrance in the form of heat activated microcapsules so that the release of the agent could be controlled.

Response to Arguments

7. Applicant's amendments have overcome the 112 (2nd paragraph) rejections from the previous Office Action.
8. Applicant's arguments with respect to claims 1, 3-11, 13-15, and 17-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **SHARON M. PRANGE** whose telephone number is (571)270-5280. The examiner can normally be reached on **M-F 7:30-5**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. M. P./ 4/8/10
Examiner, Art Unit 3728

/Mickey Yu/
Supervisory Patent Examiner, Art
Unit 3728